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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,383	08/01/2001	Shunsuke Yajima	70904-56304	4400

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EXAMINER	
JOO, JOSHUA	
ART UNIT	PAPER NUMBER
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/920,383	YAJIMA ET AL.	
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *7,9,11,13,15,17,19,21,23,25,27 and 28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

Response to Amendment filed 2/7/2007

1. Claims 1-29 are presented for examination.

Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28 are withdrawn from consideration.

Response to Arguments

2. Applicant's arguments with respect to claims 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, and 29 have been considered but are moot in view of the new ground(s) of rejection. Applicant argued that:

3. (1) Francis reference teaches, discloses or suggest that changing of information on the smart card should not be easily accomplished, and therefore would be impractical in the context of printing numerous jobs.

4. In response, Mazzagatte teaches of a smart-card containing identification information (Claim 1; Col 8, lines 19-23), and further teaches of a smart-card interface for writing on to a smart-card (Col 5, lines 23-25). However, Mazzagatte does not specifically teach of writing the identification information on to the smart-card, and thus does not teach how the identification information is on the smart-card. Therefore, Mazzagatte was combined with Francis, wherein Francis specifically teaches that information can be entered into a smart-card (Col. 3, lines 47-52; Col. 4, lines 19-23), and therefore, entering data on a smart-card is well known in the art and identification information can be written on the smart-card. As to Francis being impractical to printing numerous print jobs, the claims do not contain any limitation regarding printing numerous print jobs, and the combination of Francis and Mazzagatte teaches the scope of the claims, which is a portable data storage mans receiving identification information from the data preparation means.

Detailed Action

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5. (2) The art relied upon (Mazzagatte and Francis) in support of the currently outstanding rejections does not teach, disclose or suggest that the identification is transmitted automatically from a portable data storage device when the portable data storage device approaches the claimed electronic device. In both Mazzagatte and Francis references, the user has to insert his smart-card and this appears to be true no matter what the proximity relation of the small card reader to the printer may be.

6. In response, the claims do not define the limits of "automatically", and the claims are given the broadest reasonable level of interpretation. According to Mazzagatte, the printer reads the smart-card upon the smart-card being presented to the smart-card reader (Col. 9, lines 56-61). The smart-card being presented to the smart-card reader is approaching the printer since the smart-card is drawn near to the printer for the smart-card to be read. Furthermore, Applicant argued that the user inserts the smart-card, and therefore it is not automatic. However the claims define transmitting automatically when the portable stat storage approaches the electronic device. As stated above, in Mazzagatte, the smart-card is approached, i.e. presented, to the printer and when approached, the smart-card is read by the printer. Therefore, the printer, i.e. a machine, reading the card upon presenting is considered as automatic.

7. (3) With respect to claim 20, Peters reference merely describes a wireless notebook computer that transmits data to a printer. Applicants respectfully submit that such a substitution has nothing at all to do with the leading one of ordinary skill in the art to replace the smart card of the Mazzagatte reference with the wireless computer of the Peters reference, and one skilled in the art would replace the laptop computer 20 of the Mazzagatte reference with the wireless computer. Also, the Mazzagatte reference requires that print data be stored on a print node (a server) until authentication is received. However, the combination proposed by the Examiner would require print data to be sent directly to the printer from the wireless computer, contrary to the express teachings of the Mazzagatte reference.

8. In response, it would have been obvious to one of ordinary skill in the art that a computer may transmit data to a wireless device, e.g. wireless computer, and implement Peters' teachings of a wireless device that transmits data to a printer because the wireless device would provide an alternative storage medium (not replacing as argued by the Applicant) for storing and transmitting printer identification data. Applicant argued that one skilled in the art would replace Mazzagatte's laptop computer with Peters' wireless device. However, Examiner contends that one skilled in the art would not replace the laptop computer, but rather provide another device for portable identification storage, which would still allow secure printing by identification information for both laptop and desktop users.

9. In response to the argument that the Mazzagatte reference requires that print data be stored on a print node (a server), Mazzagatte teaches,

> Col. 7, lines 39-43, "the term "print node" means either an image forming device or a gateway to on one or multiple image informing devices. That is, the print node may be an image forming device itself provided with the capability of performing encryption and decryption tasks..."
>
> Col. 9, line 38-39, "the printer node is a printer itself..."

10. The print node is not required to be a server, and can be a printer, and therefore, Mazzagatte's teachings is not contrary to Peters. Mazzagatte teaches of a portable device providing identification information, but the portable device is not specifically a portable information processing terminal. Peters teaches of a wireless device such as wireless computer capable of directly transmitting data to a printer (Col. 4, lines 43-47), and therefore, the combination of Mazzagatte and Peters would provide a wireless device capable of transmitting identification information.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-6, 8, 10, 12, 14, 16, 18, 22, 24, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, US Patent #6,862,583 (Mazzagatte hereinafter), in view of Taniguchi et al. US Patent #6,348,972 (Taniguchi hereinafter) and Francis et al, US Patent #6,650,430 (Francis hereinafter).

13. As per claims 1 and 22, Mazzagatte teaches substantially the invention as claimed including a device and system for authenticated secure printing, Mazzagatte's teachings comprising:

data preparation means for preparing operation data and outputting the operation data, the data preparation means also preparing identification data that uniquely identifies the operation data (Col. 7, lines 46-48; Col. 8, lines 19-21. Submit print data with identification information. Col 8, lines 19-23. Obtain identification information.);

an electronic device which carries out processing based on the operation data prepared by said data preparation means (Col 9, lines 61-62. Printer prints data.); and

said portable data storage means including identification data storage means for storing the identification data (Col 8, lines 35-38. Smart card contains identification information. Col 5, lines 23-25. Write to smart card.),

wherein said portable data storage means transmits automatically the identification data stored in said identification data storage means to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.), and when said electronic device receives the identification data from said portable data storage means (Col 9, lines 56-59. Printer verifies information smart card.), said electronic device carries out the processing based on the operation data uniquely

identified by the identification data (Col 9, lines 61-62; Col 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

14. Mazzagatte teaches substantial features of the claimed invention including a smart-card interface device to write to the smart card (Col. 5, lines 23-25); and linking identification information on the smart card with the print job (Col. 9, lines 57-58). However, Mazzagatte does not specifically teach of preparing identification data uniquely identifying the operation data that is different in each instance of outputting, and receiving identification data from a data preparation device.

Taniguchi teaches of creating a print job ID that is peculiar to each print job (Col. 3, lines 36-38, 48-50).

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Taniguchi to include a print job ID that is peculiar to each print job to the identification data corresponding to the print job because Taniguchi's teachings would allow individual identification of each print job.

16. Mazzagatte and Taniguchi still do not specifically teach of receiving identification data from the data preparation device.

Francis teaches of a similar system comprising: entering identification information created from a computer into a smart card (Col. 3, lines 47-52; Col. 4, lines 19-23) and transmitting the identification information to the printer (Col. 7, lines 11-21, 37-40).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Taniguchi, and Francis to enter the identification information into the smart card because as previously stated, Mazzagatte's teaches of an interface to write to a smart-card, and both Mazzagatte and Francis' teachings deal with providing secure printing by using smart

cards. Furthermore, the teachings of Francis would enhance the system of Mazzagatte and Taniguchi by providing identification information to the smart-card and allowing updates to the identification information on the smart card.

18. As per claim 24, Mazzagatte teaches substantially the invention as claimed including a device for authenticated secure printing, Mazzagatte's teachings comprising:

a data preparation section for preparing operation data to control the operation of an electronic device and outputting the operation data, the data preparation section also preparing identification data that uniquely identifies the operation data (Col 7, lines 46-48; Col. 8, lines 19-21. Computer submits print data with identification information. Col 8, lines 19-23. Obtain identification information.);

an operation data transmitting section for transmitting the operation data prepared by said data preparation section to said electronic device (Col 8, lines 20-22, 59-61. Transmits print job along with identification information to the printer.);

a portable data storage device which stores the received identification data and automatically transmits the stored identification data to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 51-59. Smart-card contains unique identification information. Upon presenting the smart-card to the printer, printer reads the unique identification information on the smart-card.),

wherein said electronic device, upon receipt of the identification data from said portable data storage device, performs an operation based on the operation data uniquely identified by the received identification data, selected from among a plurality of operation data received from said operation data transmitting section (Col 9, lines 61-62; Col 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

19. Mazzagatte teaches substantial features of the claimed invention including a smart-card interface device to write to the smart card (Col. 5, lines 23-25) and linking identification information on the smart-card with the print job (Col 9, lines 57-58). However, Mazzagatte does not specifically teach of preparing identification data uniquely identifying the operation data that is different in each instance of outputting, and receiving identification data from a data preparation device.

Taniguchi teaches of creating a print job ID that is peculiar to each print job (Col. 3, lines 36-38, 48-50).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Taniguchi to include a print job ID that is peculiar to each print job to the identification data corresponding to the print job because Taniguchi's teachings would allow individual identification of each print job.

21. Mazzagatte and Taniguchi still do not specifically teach of receiving identification data from the data preparation device.

Francis teaches of a similar system comprising: entering identification information into the memory of the smart card (Col. 3, lines 47-52; Col. 4, lines 19-23); and transmitting information from the smart card to the printer (Col. 7, lines 36-39), wherein the smart card can be a contactless smart card or a RF identification card (Col. 3, lines 59-64).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Taniguchi, and Francis to enter the identification information into the smart card and transmit information to the printer because as previously stated, Mazzagatte's teaches of an interface to write to a smart-card, and both Mazzagatte and Francis' teachings deal with providing secure printing by using smart cards. Furthermore, the teachings of Francis would enhance the

system of Mazzagatte and Taniguchi by providing identification information to the smart-card and allowing updates to the identification information on the smart card.

23. As per claim 2, Mazzagatte teaches the electronic device control system of claim 1, further comprising: transmitting means for transmitting the operation data prepared by said data preparation means to said electronic device (Col. 8, lines 59-63. Sender submits print job and is transmitted to the printer.).

24. As per claim 3, Mazzagatte teaches the electronic device control system of claim 2 wherein: said transmitting means is a network, which connects at least one data preparation means and at least one electronic device (Fig 1. #100).

25. As per claim 4, Mazzagatte does not specifically teach the electronic device control system of claim 1, wherein: said portable data storage means receives the identification data from said data preparation means and transmits the identification data to said electronic device by wireless.

Francis teaches of a similar system comprising: entering identification information into the memory of the smart card (Col. 3, lines 47-52; Col. 4, lines 19-23); and transmitting information from the smart card to the printer (Col. 7, lines 36-39), wherein the smart card can be a contactless smart card or a RF identification card (Col. 3, lines 59-64).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Taniguchi, and Francis to provide a contactless smart-card and transmit information to the printer because the teachings of Francis would increase user-efficiency and convenience for using the system.

27. As per claim 5, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said electronic device includes operation data storage means for storing the operation data transmitted from said data preparation means (Col. 9, lines 8-10. Printer stores print data.); and

said electronic device checks the operation data stored in said operation data storage means against the identification data received from said portable data storage means when receiving the identification data (Col. 9, line 56-58. Printer verifies the identification information from smart card.), detects the operation data corresponding to the received identification data (Col. 10, lines 14-18. Compares information from smart card with identification stored in print queue.), and carries out the processing based on the operation data (Col. 10, line 20. Printout process.).

28. As per claim 6, Mazzagatte teaches the electronic device control system of claim 3 further comprising: operation data management means (Col. 6, line 62. Server), connected to said network, for storing the operation data prepared by said data preparation means and for managing a data output process to output the operation data to said electronic device (Col. 6, lines 62-65. Server queues print data and sends data to a printer.).

29. As per claim 8, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said electronic device includes display means (Col. 9, line 65. Display on printer.); and

said electronic device includes control means which confirms the content of the operation data (Col. 9, lines 7-14. Process print data for secure storage.), judges whether or not said electronic device has function means for performing a selected function required to perform an operation based on the operation data (Col 9, lines 57-59; Col 10, lines 17-19. Determine if print jobs are queued for print out based on identification information.), then indicates the judgment result on said display means (Col. 9, lines 65-66; Col. 10, lines 20-24. Displays notification.).

30. As per claim 10, Mazzagatte teaches the electronic device control system of claim 1, wherein:

said portable data storage means also stores user management identification data (Col. 8, lines 20-37. Smart card contains identification information such as name, organization, and other information.), and transmits user management identification data on said electronic device (Col. 9, lines 53-58. Printer reads and verifies the identification information.); and

said electronic device controls to limit the performance of an operation of said electronic device based on the user management identification data received from said portable data storage means (Col. 9, lines 60-64. If identification information is verified, printer proceeds with printout process. If not, notification is made of failure.).

31. As per claim 12, Mazzagatte teaches the electronic device control system of claim 10, wherein:

the user management identification data includes data of at least one kind selected from the group consisting of department identification data identifying the department in which said data preparation means for preparing operation data is installed (Col. 8, lines 27-30. Identification information includes organization unit.), user identification data set for each user (Col. 8, lines 27-30. User's information.), and storage means identification data for each portable storage means (Col. 8, lines 34-38. Smart card contains identification information.).

32. As per claim 14, Mazzagatte teaches the electronic device control system of claim 10 wherein:

the user management identification data is registered in said portable data storage means in advance (Col. 8, lines 25-30, 33-37. Smart card contains identification information including user information and authentication data.).

33. As per claim 16, Mazzagatte teaches the electronic device control system of claim 1, wherein: said electronic device is an image output device (Col 9, lines 57-58. Printer.), and the operation data is print data (Col. 9, lines 9. Print data.).

34. As per claim 18, Mazzagatte teaches the electronic device control system of claim 1, wherein: said data preparation means is a personal computer (Col 7, lines 46-47. Desktop computer.).

35. As per claim 29, Mazzagatte teaches the electronic device control system of claim 16, wherein said operation data corresponds to a single print job (Col. 8, lines 19-20. Print job.)

36. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, Taniguchi, and Francis, in view of Peters, US Patent #6,601,093 (Peters hereinafter).

37. As per claim 20, Mazzagatte teaches that the portable data storage may be a smart card (Col 8, lines 33-34). However, Mazzagatte does not specifically teach that portable data storage means includes at least one element selected from the group consisting of a portable phone; and a portable information processing terminal.

Peters teaches of a wireless device, such as a wireless notebook computer, transmitting data to a printer (Col. 4, lines 36-50).

38. It would have been obvious to one of ordinary skill in the art that a computer is capable of transmitting data to wireless device such as wireless computer, and combine the teachings of Mazzagatte, Taniguchi, Francis, and Peters to implement a wireless device capable of transmitting data to a printer, which would provide an alternative portable device for transmitting identification information and increase the field of use of the system.

39. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, in view of Taniguchi.

40. As per claim 26, Mazzagatte teaches substantially the invention as claimed including an electronic device comprising:

an operation data receiving section for receiving operation data from a data preparation device which prepares and outputs the operation data, the data preparation device also preparing identification data that uniquely identifies the operation data (Col. 7, lines 46-48; Col. 8, lines 19-23, 58-63; Col. 9, lines 8-10. Computer transmits print data along with identification data to printer. Computer obtains identification information.);

an identification data receiving section for receiving the identification data transmitted automatically from a portable storage device when the portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer reads and verifies the unique identification information from the smart-card.), the identification data receiving section having a function to store the identification data received from said data preparation device (Col. 9, lines 52-55. Verifies identification information from smart card. Col. 10, lines 15-19. Use identification information from the smart card to identify Identification information stored in print queue.); and

an operation section for performing an operation based on the operation data which is received by said operation receiving section and is uniquely identified by the identification data received by said identification data receiving section (Col. 9, lines 61-62; Col. 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

41. Mazzagatte teaches substantial features of the claimed invention including identification data corresponding to the print job (Claim 1; Col. 8, lines 19-23). However, Mazzagatte does not specifically teach of preparing identification data uniquely identifying the operation data that is different in each instance of outputting.

Taniguchi teaches of creating a print job ID that is peculiar to each print job (Col. 3, lines 36-38, 48-50).

42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Taniguchi to include a print job ID that is peculiar to each print job to the identification data corresponding to the print job because Taniguchi's teachings would allow individual identification of each print job.

Conclusion

43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

44. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

46. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 1, 2007
JJ